

Appl. No. 10/724,320
Amdt. dated July 5, 2004
Reply to Office action of April 9, 2004

Docket No. 59124-010201

REMARKS

Examination of the present application is to be based on claims 1, 4-11, 14-18 and 20-24, where claims 2-3, 12-13 and 19 have been cancelled and claims 21-24 have been added.

The office action of April 9, 2004 and the art relied on by the Examiner have been carefully examined. In the Action, the Examiner raises objections and rejections under § 101, 112, 102, and 103. The Applicant will deal with the rejections under § 112 first, for the sake of clarity.

I. Claim Rejections – 35 USC §112

In the Action, the Examiner rejects claims 1-20 under 35 USC § 112, second paragraph.

The Applicant has amended the claims to introduce appropriate modifications and submits that the amended claims overcome the objections of the Examiner.

The Applicant also submits that amendments to the claims responsive to the rejections under 35 USC § 112, second paragraph, have been introduced for clarity purposes only and that no limitations have been introduced into the claims in order to respond to the rejections under 35 USC § 112, second paragraph.

II. Amendments to the claims

Claim 1 has been amended to recite the wording: “... *providing fastening devices for use on apparel articles; modifying the shape of the fastening devices to give the fastening devices an appearance of characters to be portrayed in a story* ...”

Claim 11 has been amended to recite the wording “... *a group of fastening devices for use on apparel articles, the fastening device having an appearance of characters to be portrayed in a story...*”.

Claims 18 has been amended to include the wording: “... *fastening devices for use on different apparel articles, the fastening devices having an appearance of characters...*”.

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Support for the above amendments can be found, for example, in Figure 1 of the present application and related portions of the specification, and in claims 2, 3, 12, 13, and 19 as originally filed.

Claim 1 has also been amended to recite: “...*in order to facilitate childhood learning on how to manipulate the fastening devices*...”

Claim 9 has also been amended to recite: “...*in order to facilitate childhood learning on how to manipulate the fastening device*...”

Claims 11 and 18 have also been amended to recite: “...*wherein association between the fastening devices and the media facilitates childhood learning on how to manipulate the fastening devices*...”

Support for the above amendments can be found, for example in paragraph [0022] of the specification.

The Applicant submits that no new matter has been added.

III. New claims

New claims 21 to 24 have been added. Support for new claims 21-24 can be found in Figure 1 and related portions of the specification and in claims 2, 3, 12, 13, and 19 as originally filed. The Applicant submits that no new matter has been added.

IV. Claim Rejections – 35 USC §101

In the Action, the Examiner rejects claims 1-20 under 35 USC 101 as non-statutory subject matter (see Action page 2). The Applicant respectfully submits that the new set of claims 1, 4-11, 14-18 and 20-24 complies with the requirements of § 101 for the reasons that follow, where reference will be made to independent claims 1, 9, 11, and 18.

Claim 1 recites “*fastening devices*” and “*modifying the shape of the fastening devices*.” Fastening devices relate to technological arts, while modifying the shape of the devices is a “concrete step.” Therefore, claim 1 satisfies to the requirements of § 101.

Similar considerations apply to claim 9.

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Claim 11 recites "*fastening devices for use on apparel articles*," the fastening devices being concrete, mechanical objects, pertaining to the technological arts. Therefore, claim 11 satisfies to the requirements of § 101.

Similar considerations apply to claim 18.

Therefore, the Applicant submits that independent claims 1, 9, 11, and 18 comply with the requirements of 35 USC § 101, together with their dependent claims 4-8, 10, 14-17, and 20-24.

V. Claims rejections - 35 USC § 102

On page 3 and 4 of the Action, the Examiner rejects old claims 1, 6-8, 11, and 18 under 35 USC §102 as anticipated by Thomas the Tank Engine books (hereinafter referred a "Thomas").

The Applicant initially points out that, in order for a valid § 102 rejection to be made, reference must be made to a single piece of prior art and not to a plurality of pieces of prior art, such as those used by the Examiner. At most, a § 103 could be made, by combining two or more of those references.

The Applicant further points out that the Examiner apparently makes reference to the contents of the books represented. However, a copy of those contents has not been provided to the Applicant.

Finally, the Applicant notes that independent claims 1, 9, 11, and 18 enclosed with the present response all recite "fastening devices", and that the references cited by the Examiner do not show fastening devices, as also noted by the Examiner in his comments with reference to the § 103 rejections.

Therefore, the Applicant submits that a § 102 rejection is inapplicable to the currently pending claims. As a consequence, it is submitted that all currently pending claims are novel over Thomas.

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VI. Claims rejections - 35 USC §103(a)

On page 4 and 5 of the Action, the Examiner rejects old claims 2-5, 9, 10, 12-17, and 19-20 under 35 USC § 103(a) as unpatentable over Thomas. The Applicant respectfully disagrees for the reasons that follow.

Thomas shows a train having a human face. As pointed out at page 4/7 of Thomas, the reference is used "to introduce children to the alphabet and their numbers." Also, the children are taught on how to "associate letters with appropriate objects and recognize number representation with appropriate grouping."

Therefore, if the person skilled were to modify the teachings of Thomas, he would still be compelled to follow the rationale behind Thomas, i.e. teaching letters and numbers.

It follows that the person skilled in the art would never be prompted to replace a train with a fastening device or devices because, in accordance with the wording of independent claims 1, 9, 11, and 18, children are taught on how to "manipulate" those fastening devices.

The Applicant respectfully reminds the Examiner that the "proposed modification [of a piece of prior art for § 103 purposes] cannot render the prior art unsatisfactory for its intended purpose" (see MPEP 2143.01). In other words, replacing a train with fastening devices would defeat the purpose in Thomas, which is that of teaching letters and numbers.

In sharp contrast, the present application teaches how to manipulate the fastening devices.

Therefore, Applicant submits that claims 1, 9, 11, and 18 are non-obvious and patentable over Thomas, together with the remaining claims, which directly or indirectly depend on such claims 1, 9, 11, and 18.

* * *

The Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Since the Applicant was not in condition to fully analyze the Thomas reference cited by the Examiner, should the Examiner still be of the opinion to use the Thomas reference in a future

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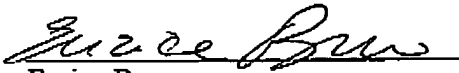
Action, the Examiner is respectfully requested to do so in a further non-final action, also enclosing a complete copy of the prior art cited.

Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

The Applicant believes that no fee is due for the submission of the present paper. However, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

Date: July 9, 2004


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Limited Recognition (Attached)

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Expires: March 23, 2005


Harry I. Moatz
Director of Enrollment and Discipline